PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Richard A. Dixon *et al.*	Group Art Unit: 1638
Serial No.: 10/659,755	Examiner: Kallis, Russell
Filed: September 10, 2003	Atty. Dkt. No.: NBLE:007US
For: METHODS AND COMPOSITIONS FOR PRODUCTION OF FLAVONOID AND ISOFLAVONOID NUTRACEUTICALS	

CERTIFICATE OF ELECTRONIC SUBMISSION

Date of Submission: June 23, 2006

RESPONSE TO RESTRICTION REQUIREMENT DATED MAY 23, 2006

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Commissioner:

This paper is submitted in response to the Restriction Requirement dated May 23, 2006 for which the date for response is June 23, 2006. It is believed that no fee is due in connection with this paper; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/NBLE:007US.

In response to the restriction which the Examiner imposed, Applicants elect, with traverse, to prosecute claims 1-35 and 46-50, *i.e.*, the Group II claims.

The traversal is made with respect to the restriction between the Group I and II claims on the basis on that the claims are generically linked. Specifically, claim 1 reads as follows:

1. A method of increasing isoflavonoid biosynthesis in a plant comprising:
   a) down-regulating flavanone 3-hydroxylase in said plant; and
   b) up-regulating isoflavone synthase and/or the production of a substrate thereof in said plant.

As can be seen, the claim does not require transgenic or non-transgenic modification of either flavanone 3-hydroxylase or up-regulating isoflavone synthase. The limitation is found only in dependent claims, and thus it is not proper to limit examination so as to not cover the generic linking claim. Specifically, in a restriction requirement, generic or other linking claims must be examined with the linked inventions and the presence of the linking claim should be clearly noted on the record. See MPEP §814.

In regard to the foregoing Applicants respectfully draw attention to the decision by the Court of Appeals for the Federal Circuit in *In re Michael P. Doyle*, which noted that an applicant may prosecute generic, linking claims "without running afoul of the restriction requirement *because they are linking claims*." 293 F.3d 1355, 1360 (Fed. Cir., 2002), *citing* MPEP §809.03 (8th ed. 2001) (emphasis added). Indeed, the Court held that the failure to present generic claims in the original prosecution of an application was an error correctable by broadening reissue. *Id.* at 1361-1362. Further, the Federal Circuit noted that allowance of a linking claim prompts the examination of covered claims, stating that "[t]he MPEP expressly provides that '[I]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.'" *Id.* at 1362., *citing* MPEP § 809.04 (emphasis added by the Court). Consideration of all of the Group I and Group II claims is thus respectfully requested.

The Examiner is invited to contact the undersigned attorney at (512) 536-3085 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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